

REMARKS

In the present Office Action, claims 1-25 and 27-31 were examined. Claims 1-25 and 27-31 have been rejected by the Examiner.

By this Amendment, claims 2, 14 and 29 have been amended and claim 30 has been canceled. No new matter has been added. Accordingly, claims 1-25, 27-29 and 31 are presented for further examination. By this Amendment, all claims are believed to be in condition for allowance.

Responsive to 35 USC 112 Objections

The Applicants gratefully acknowledge the withdrawal of the claim objections to claims 20, 25 and 27.

Obviousness – Type Double Patenting Rejection

The Applicants gratefully acknowledge the withdrawal of the obvious-type double patenting rejection against claims 1, 3, 5-19, 21-26 and 28-30 due to the Terminal Disclaimer filed on February 28, 2005.

Responsive to 35 USC 112 Rejections

Claims 2, 14 and 29 were rejected under 35 USC 112, second paragraph for containing terms that were vague and indefinite. Specifically, the term “organic amine” in claim 2, the word “comprising” in claim 14 and the term “amine” in claim 29 were identified as vague and indefinite.

Correction to claims 2, 14 and 29 are made in accordance with suggestions of the Examiner. Specifically, in claim 14, the term “comprising” has been amended to “including”. In claim 29, the term amine has been amended to be limited to specific amines originally cited in claim 30, which is herein canceled. Likewise, in claim 2, the term “organic amine” has been amended to be limited to the specific amines recited, as supported by the disclosure, provided in

claim 30 as originally filed. Claim 30 has been canceled herein. Therefore, the 35 USC 112 Rejection to claims 2, 14 and 29 are believed to have been overcome by virtue of these amendments.

Responsive to 35 USC 103 Rejection

The claims stand rejected under 35 USC 103 as allegedly obvious over U.S. Patent No. 6,103,822 to Housel, et al. in view of WO 98/50338 to Koistinen, et al. This rejection is believed to be untenable.

Housel, et al. discloses polymeric acid functional polyols which are the reaction product of at least one hydroxyl-terminated polymer and a nonaromatic anhydride. Acid functional polyols according to Housel, et al. having the preferred hydroxyl functionality and acid and hydroxyl values can be derived from a reaction of either: (1) a nonaromatic polyanhydride with at least one polymer; or (2) at least one polyol and/or dicarboxylic acid with a component having at least two unhindered functional groups and at least one hindered carboxylic acid functional group. Further, Housel, et al. discloses the use of an organometallic catalyst, such as organotin to control the reaction.

Housel refers at page 8, lines 3 to 9 to the problems associated with catalysts in the statement "If the reaction, through the use of certain catalysts or a temperature which is too low, occurs too slowly, conversion to an acid functional polyol will take too long. However, if as a result of the use of particular catalysts or a temperature which is too high, the reaction proceeds too quickly, unwanted side reactions, as discussed above, could occur." Housel, et al. raises these potential problems, but neither discloses nor suggests any solution. Furthermore, Housel, et al. does not disclose or suggest any catalyst other than an organometallic catalyst, such as organotin.

At page 8 of the office action it states "[t]herefore it would have been obvious to the skillful artisan in the art to be motivated to employ Koistinen's et al. hydrochloric acid into the Housel et al process as an alternative to the Housel's et al tin oxide because the skilled artisan in the art would expect such a modification to be successful and effective as guidance shown in

Koistinen et al.” Applicants respectfully disagree with the Examiner and submit that there is no suggestion or motivation to combine the disclosure of Koistinen, et al. with the disclosure of Housel, et al.

Koistinen, et al. discloses a process for manufacturing polyol complex esters. According to the method, a polyol, such as BEPD or NPG, is reacted with mono- and polyvalent acids in the presence of a catalyst to produce a reaction blend containing complex esters. More specifically, as disclosed in Examples 1-3 and 5-31 of Koistinen, et al., complex esters of BEPD (2-butyl-2-ethyl-1,3-propanediol) were manufactured by combining BEPD and saturated linear or branched monocarboxylic acid or unsaturated carboxylic acid and diacid. While acid catalysts, such as sulphuric acid and hydrochloric acid, are mentioned in dependent claim 17, the catalyst employed in working examples 1-3 and 5-31 was tin oxide.

One of ordinary skill in the art, reviewing the reaction disclosed in Housel, et al. and taking into account the statement concerning potential catalyst problems, would not stray from the teaching set forth in Housel, et al. and therefore would not be motivated to combine the Housel disclosure with the disclosure of Koistinen, et al. Specifically, one of ordinary skill in the art would not deviate from Housel, et al. by using a catalyst that is entirely different from the one discussed in the specification. Therefore, one of ordinary skill in the art would not look to Koistinen, et al. to modify the catalyst used in Housel, et al.

Furthermore, Applicants submit that even if one of ordinary skill in the art looked to Koistinen, et al. to modify Housel, et al., tin oxide would be used as a catalyst since tin oxide was specified as the catalyst utilized in Examples 1-3 and 5-31.


Accordingly, the combination of the Housel, et al. reference and the Koistinen, et al. reference does not support a prima facie case for obviousness under 35 USC 103(a). The Applicants respectfully submit the rejection has been overcome and request the Examiner withdraw the present rejection.

If the Examiner has any questions or believes that a discussion with Applicant's attorney would expedite prosecution, the Examiner is invited and encouraged to contact the undersigned at the telephone number below.

Please apply any credits or charge any deficiencies to our Deposit Account No. 23-1665.

Respectfully submitted,
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